



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,296	01/23/2004	Brent J. Garback	6948-1	8258
28765 7590 05/02/2007 WINSTON & STRAWN LLP PATENT DEPARTMENT 1700 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER LIU, ERIC	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/764,296

Applicant(s)

GARBACK, BRENT J.

Examiner

Eric Liou

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/23/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 12 and 13 are objected to because of informalities. Appropriate correction is required.
2. Claim 12 recites the limitation “wherein the venue information includes...” It appears that that the Applicant intended claim 12 to depend on claim 11 because the limitation recited in claim 11 defines venue information. For examination purposes, the Examiner interprets claim 12 to depend on claim 11.
3. Claim 13 recites the phrase “the vendor” in line 9. The phrase should be changed to “the at least one vendor” in order to stay consistent with the rest of the claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. As per claims 19-20, the preamble recites “a machine readable program...”, however, does not recite that the program is encoded or recorded on a physical medium readable by a computer. Thus, the claim is directed to functionally descriptive material that is not functionally or structurally interrelated to the medium. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are neither physical “things” nor statutory processes. Such claimed data structures do not define any

Art Unit: 3628

structural and functional interrelationships between the data structure. See MPEP

2106(IV)(B)(1)(a).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 13-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 13-18 are written in “single means claim” format since they recite only one element to do all the functions recited. The claim is not written in “means-plus-function” language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use “means-plus-function” language. Claims 13-18 are drawn to any “computer” regardless of construct that performs the function recited. This parallels the fact situation in *Fiers* wherein “a DNA” and a result was recited. The CAFC stated in *Fiers* at 1606 “Claiming all DNA’s that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived”. See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to

Art Unit: 3628

single means claims even though "means" was not literally used. Thus, claims 13-18 yield a "computer" that achieves a result without defining what will do so.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2-4, 7-10, and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 2 and 7-10 recite the limitation "the travel itinerary". There is insufficient antecedent basis for this limitation in the claims.

12. Claim 4 recites the limitation "the website of the vendor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. As per claim 13, it is unclear which statutory class the claim belongs to. The preamble recites a computer while the body recites method steps without any structural components.

14. Claim 16 recites the limitation "the additional travel information" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

15. Claim 18 recites the limitation "group member information" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3628

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garback, U.S. Patent Number 5,237,499 in view of Chen et al., U.S. Publication No. 2002/0152100.

18. As per claim 1, Garback teaches a method of managing travel within a sponsoring organization, comprising: receiving a travel request submitted for a group member of the sponsoring organization (Garback: column 5, lines 25-30); identifying travel information from at least one vendor authorized by the sponsoring organization (Garback: column 2, lines 24-27 and 40-45), wherein the travel information includes financial rates previously established between the vendor and the sponsoring organization (Garback: column 2, lines 24-27); automatically comparing the identified travel information to alternative travel information (Garback: column 5, lines 42-46), the alternative travel information including available financial rates offered through at least one alternative source (Garback: column 5, lines 42-46, fares available from other airline flights from the airline CRS systems); and selecting travel information from the comparing step for reservation for the group member (Garback: column 5, lines 46-56). Garback does not teach using an internet based source.

19. Chen teaches using an internet based source (Chen: paragraph 0014, "...the system and method for travel management utilizing multiple computer reservation systems for making travel related bookings can be Internet based.").

20. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Garback to have included using an internet

Art Unit: 3628

based source as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

21. As per claim 2, Garback in view of Chen teaches the method of claim 1 as described above. Garback further teaches the step of providing group member information, wherein the travel itinerary is constructed based at least in part on the group member information (Garback: column 2, lines 64-68 and column 3, lines 1-3).

22. As per claim 3, Garback in view of Chen teaches the method of claim 2 as described above. Garback further teaches the group member information includes information relating to at least one of the group member's seating preference and frequent flier information (Garback: column 2, lines 64-68 and column 3, lines 1-3).

23. As per claim 4, Garback in view of Chen teaches the method of claim 2 as described above. Garback further teaches the group member information is obtained from the vendor (Garback: column 3, lines 34-38). Garback does not teach using a website to obtain information.

24. Chen teaches using a website to obtain information (Chen: paragraph 0014 – The Examiner notes, obtaining information from an Internet based system implies that a website is used to obtain information).

25. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Garback to have included using a website to obtain information as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

Art Unit: 3628

26. As per claim 5, Garback in view of Chen teaches the method of claim 1 as described above. Garback further teaches providing a comparative analysis to the group member, the comparative analysis identifying the alternative travel information identified by the comparing step (Garback: column 5, lines 46-56 and 34-37 and column 4, lines 63-67 – The Examiner interprets travel information to include the comparative analysis.).

27. As per claim 6, Garback in view of Chen teaches the method of claim 5 as described above. Garback further teaches the at least one vendor provides services related to (1) airline services, (2) ground transportation and (3) room accommodations (Garback: column 5, lines 30-33).

28. As per claim 7, Garback in view of Chen teaches the method of claim 6 as described above. Garback further teaches the travel itinerary includes airline services based on a previously established financial rate (Garback: column 5, lines 30-33 and 46-50).

29. As per claim 8, Garback in view of Chen teaches the method of claim 7 as described above. Garback further teaches the travel itinerary includes ground transportation based on a previously established financial rate (Garback: column 5, lines 30-33 and 46-50).

30. As per claim 9, Garback in view of Chen teaches the method of claim 8 as described above. Garback further teaches the travel itinerary includes room accommodation based on a previously established financial rate (Garback: column 5, lines 30-33 and 46-50).

31. As per claim 10, Garback in view of Chen teaches the method of claim 1 as described above. Chen further teaches the step of reserving the travel itinerary over the internet (Chen: paragraph 0014, "...the system and method for travel management utilizing multiple computer reservation systems for making travel related bookings can be Internet based.").



Art Unit: 3628

32. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Garback to have included the step of reserving the travel itinerary over the internet as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

33. As per claim 11, Garback in view of Chen teaches the method of claim 1 as described above. Garback further teaches the step of providing venue information about a specific venue for which the group member is making travel arrangements (Garback: column 2, lines 27-36).

34. As per claim 12, Garback in view of Chen teaches the method of claim 11 as described above. Garback further teaches the venue information includes information relating to (1) a date on which an event begins, (2) a date on which an event ends and (3) the location of the event (Garback: column 2, lines 27-36).

35. As per claim 13, Garback teaches a system for managing travel within a sponsoring organization, comprising a computer (Garback: Figure 1, "22") configured to: process a travel request inputted for a group member of the sponsoring organization (Garback: column 5, lines 25-30); access a database containing identified travel information from at least one vendor authorized by the sponsoring organization in response to the inputted travel request, wherein the travel information includes financial rates previously established between the vendor and the sponsoring organization (Garback: column 2, lines 20-54 and column 5, lines 42-56); compare the identified travel information to alternative travel information (Garback: column 5, lines 42-46), the alternative travel information including available financial rates offered through an alternative source (Garback: column 5, lines 42-46, fares available from other airline flights from

Art Unit: 3628

the airline CRS systems); select travel information based upon the comparison for reservation for the group member (Garback: column 5, lines 46-56); and reserve a travel itinerary over the internet for the group member (Garback: column 5, lines 46-56). Garback does not teach using an internet based source.

36. Chen teaches using an internet based source (Chen: paragraph 0014, "...the system and method for travel management utilizing multiple computer reservation systems for making travel related bookings can be Internet based.").

37. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Garback to have included using an internet based source as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

38. As per claim 14, Garback in view of Chen teaches the system of claim 13 as described above. Garback further teaches the computer is further configured to display the travel itinerary on a display (Garback: Figure 1, "22", column 4, lines 63-67, and column 5, lines 34-37).

39. As per claim 15, Garback in view of Chen teaches the system of claim 14 as described above. Garback further teaches the display is a personal computer (Garback: Figure 1, "22").

40. As per claim 16, Garback in view of Chen teaches the system of claim 13 as described above. Garback further teaches the additional travel information includes rates that have not been previously established (Garback: column 5, lines 51-54).

41. As per claim 17, Garback in view of Chen teaches the system of claim 16 as described above. Garback further teaches the computer is configured to select the lower of the previously

Art Unit: 3628

established financial rate and the non-previously established financial rate (Garback: column 5, lines 54-56).

42. As per claim 18, Garback in view of Chen teaches the system of claim 13 as described above. Garback further teaches the group member information is accessed from the database (Garback: column 2, lines 64-68 and column 3, lines 1-3).

43. As per claim 19, Garback teaches a machine readable program containing instructions for controlling a device for managing travel within a sponsoring organization (Garback: column 5, lines 25-30), comprising: means for receiving a travel request submitted for a group member of the sponsoring organization (Garback: Figure 1 and column 5, lines 25-30); means for identifying travel information from at least one vendor authorized by the sponsoring organization (Garback: Figure 1 and column 2, lines 24-27 and 40-45), wherein the travel information includes financial rates previously established between the vendor and the sponsoring organization (Garback: column 2, lines 24-27); means for automatically comparing the identified travel information to alternative travel information (Garback: Figure 1 and column 5, lines 42-46), the alternative travel information including available financial rates offered through at least one alternative source (Garback: column 5, lines 42-46, fares available from other airline flights from the airline CRS systems); and means for selecting travel information from the comparison for reservation for the group member (Garback: Figure 1 and column 5, lines 46-56). Garback does not teach using an internet based source.

44. Chen teaches using an internet based source (Chen: paragraph 0014, "...the system and method for travel management utilizing multiple computer reservation systems for making travel related bookings can be Internet based.").

Art Unit: 3628

45. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the machine readable program of Garback to have included using an internet based source as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

46. As per claim 20, Garback in view of Chen teaches the machine readable program of claim 19 as described above. Garback further teaches the program is configured to automatically reserve a travel itinerary for the group member (Garback: column 5, lines 46-50). Garback does not teach using the internet.

47. Chen teaches using the internet (Chen: paragraph 0014, "...the system and method for travel management utilizing multiple computer reservation systems for making travel related bookings can be Internet based.").

48. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the machine readable program of Garback to have included using the internet as taught by Chen for the advantage of allowing a client to access multiple computer reservation systems in order to choose the best travel item to suit their needs (Chen: paragraph 0015).

### ***Conclusion***

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim,

Art Unit: 3628

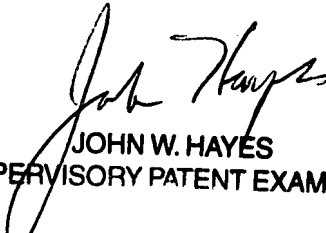
other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EL

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER